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EXAMINER KARMIS, STEFANOS				
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/728,152
Filing Date: December 01, 2000
Appellant(s): GILBERT, MICHAEL H.

Ronald Reichman
Reg. No. 26,796
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 08 March 2010 appealing from the Office action mailed 15 October 2009.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

A decision regarding this application was made by the Board of Appeals on March 24, 2009.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1-18 are rejected and pending in this application.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except

for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

2002/0026394 A1	SAVAGE ET AL	2-2002
6,697,843 B1	CARLIN ET AL	2-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
3. Claims 1-5 and 8-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Savage, U.S. Publication No. 2002/0026394 A1.

Regarding the rejection of claims 1-5 and 8-16, the Examiner notes the decision of The Board of Patent Appeals and Interferences which issued a decision on the claims on 24 March 2009. In the decision, the Board found claims 1-5 and 8-16 to be unpatentable under 35 U.S.C. § 103(a) over Savage.

Applicant's amendment of generating by a fourth computer unit the bill based upon the billing information to the customer in the form of electronic data with billing information suitable for printing; and transmitting by a fourth cmoputer unit the bill, to an optimal mailing location for printing and mailing to the customer has already been considered by The Board of Patent Appeals and Interferences (see Board Decision, mailed 24 March 2009, pages 11-12 and discussion regarding claim 6 and 7). Therefore, the amendment to the claim 1 is entered and Applicant's argument is not persuasive.

4. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Savage, U.S. Publication No. 2002/0026394 A1 in view of Carlin U.S. Patent No. 6,697,843 B1.

Regarding the rejection of claims 6 and 7, the Examiner notes the decision of The Board of Patent Appeals and Interferences which issued a decision on the claims on 24 March 2009. In the decision, the Board found claims 6 and 7 to be unpatentable under 35 U.S.C. § 103(a) over

Savage in view of Carlin. Since there are no new amendments to the claims, the rejection stands as stated by the Board.

(10) Response to Argument

The Examiner summarizes the various points raised by the Appellant and addresses them individually.

A. Rejection of claims 1-5 and 8-18 under 35 U.S.C. § 103(a) over Savage.

1. Regarding independent claim 1, Appellant has not provided any arguments against Savage. Therefore, the rejection of independent claim 1 is maintained. Instead, Appellant is arguing against dependent claims 8, 17, and 18.
2. Regarding dependent claim 8, Appellant argues that the cited prior art fails to teach *processing by a fifth computer unit payment information received from the customer; and allocating by a sixth computer unit payments, based on the payment information, to pay service providers at the multiple tiers from the payment information received from the customer.*

In Response: Appellant's arguments have been fully considered but they are not persuasive. In response Appellant has failed to point out the Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Nonetheless, Savage does teach the

limitation. Specifically, Savage teaches that the account management system maintains the payment hierarchy by determining business rules and allocating payment to products (paragraph 0096). Savage further teaches calculating the charges (paragraph 0096). Savage further teaches that the user that the user receives a bill with the various payment amounts from different billers (paragraph 0110 and Figs. 24-29). Savage then teaches a payment processing system which receives payment and posts the payment to the appropriate accounts including forwarding payment to clients (paragraph 0110; Examiner notes this is analogous to allocating payment based on the billing and payment information to pay the service providers, i.e. long distance carriers, etc.).

For these reasons, Appellant's arguments regarding claim 8 is not persuasive and thus claim 8 remains rejected.

3. Regarding dependent claims 17 and 18, Appellant argues that the cited prior art fails to teach *performing data mining using the usage information, the customer profile information and the payment information as well as using the results of the data mining to determine which additional services to offer to the customer..*

In Response: Appellant's arguments have been fully considered but they are not persuasive. In response Appellant has failed to point out the Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Nonetheless, Savage does teach the limitations. Specifically, Savage teaches that advantages of the system include upselling

customers of the financial institution's clients to become credit card customers and maximizing data mining opportunities across the system (paragraph 0013). Savage teaches that the financial institution's revenues are increased through marketing and information data mining in which marketing information includes customer information and payment information (paragraph 0020-0021 and 0060-0061 and 0063). Examiner notes that Appellant states the advantage of the claim limitation is that customers benefit by receiving one (or a fewer number) of integrated bills which provide them valuable information to optimize their selection of providers in each tier in a vertical multi-tier service (see Appeal Brief, page 10). Similarly, Savage teaches incentivizing users by allowing them to have combined billing in dealing with various providers including add on or supplemental offers (paragraphs 0018-0021 and 0060-0061 and 0063).

For these reasons, Appellant's arguments regarding claim 17 and 18 are not persuasive and thus claim 17 and 18 remain rejected.

B. Rejection of claims 6 and 7 under 35 U.S.C. § 103(a) over Savage in view of Carlin.

4. Regarding dependent claims 6 and 7, Appellant agrees that the claims are not patentable over the cited art. Therefore claims 6 and 7 stand rejected.

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,
/Stefanos Karmis/
Primary Examiner, Art Unit 3693
7 June 2010

Conferees:

/Hani M. Kazimi/

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Vincent Millin /vm/
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